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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,451	01/14/2002	John J. Leonard	1867 P 025	4714
7590	10/15/2003		EXAMINER	
Micheal D. Lake Wallenstein & Wagner, Ltd. 311 South Wacker Drive, 53rd Floor Chicago, IL 60606-6630			GARBER, CHARLES D	
			ART UNIT	PAPER NUMBER
			2856	

DATE MAILED: 10/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/046,451	LEONARD ET AL.
	Examiner	Art Unit
	Charles Garber	2856

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 January 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 23-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 23-50 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 November 2002 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3.9</u> .	6) <input type="checkbox"/> Other: _____ .

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 24 and 47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 24, the disclosure as originally filed did not include combinations of air pressure, hydraulic pressure, electric motor for actuating the ram.

As for claim 47, the disclosure as originally filed did not include comparing a quantity of conductance, dielectric value, impedance, inductance, resistance and capacitance.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 38, 42 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 38 and 39 recite "the electrode is in contact with the liquid". It is unclear if this is referring to the first or second electrode, rendering the claim indefinite.

Claims 42 and 43 depending from indefinite claims 38 and 39 respectively are indefinite for the same reason.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 23, 25, 26, 28, 30 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Helms (US Patent 3,418,843).

Regarding claim 23, Helms discloses a can body testing machine. The recitation that testing is on “liquid-filled” containers has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

The apparatus includes a clamp having a first and second clamping elements (22, 23) or members for securing a container between the members as shown in figures 4 and 5.

Cylinder 41 with rod 43 is a ram connected to the clamping elements to provide relative movement between the first and second elements or members.

Tank 49 is a liquid-filled tank situated with respect to the clamp such that at least a portion of a container secured between the first and second members may extend into

the tank and a closure of the container be submerged in the liquid as shown sequentially in figure 2 and 3.

As for claim 25, base 4 is a seat to support a container in a desired position to be secured by the clamping elements.

As for claim 26, plug 1, as shown in figure 6, with various passages and bores, forms an aperture in a container while being secured in the clamp.

As for claim 28, plug 1, as shown in figure 6, with various passages and bores, forms an aperture in a container C.

As for claim 30, Helms discloses a carriage 25 shown in the figures which is a support for the plug 1. The carriage shown on an angled track 26 accommodates vertical and horizontal movement of the plug as shown in the side views of figures 1 and 2.

As for claim 31, Helms discloses a carriage 25 shown in the figures which is a support for the plug 1. The carriage shown on an angled track 26 accommodates vertical and horizontal movement of the plug as shown in the side views of figures 1 and 2.

Claim 50 is rejected under 35 U.S.C. 102(b) as being anticipated by Konieczka (US Patent 5,535,618).

Konieczka discloses a method for evaluating the integrity of a seal on a liquid-filled container 2 comprising: immersing at least a closure portion 8 of the container 2 in the liquid of a liquid 9 filled tank 14; forming an aperture in a wall of the container 7; providing a first electrode 1 in the aperture formed in the container and providing a

second electrode 13 in the liquid-filled tank 14 (see figure 1 and abstract). Konieczka also discloses the sealed container is not leaking if there is no electric current flowing or electrical conductivity between the two electrodes, and the sealed container is leaking if there is electric current flowing or electrical conductivity between the two electrodes. This is considered to be substantively equivalent to electrically comparing the first and second electrodes.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Helms (US Patent 3,418,845).

Helms discloses the cylinder/rod or ram discussed above with respect to claim 23 is actuated by fluid pressure which may include air pressure and hydraulic pressure. (column 3 lines 69-72).

Though Helms lacks the ram may actuated by an electric motor one Examiner considers this widely known in the art and one having ordinary skill in the art would have known that electric motors may be used to used directly actuate a ram or indirectly to operate a pump providing fluid power to the ram cylinder. An electric motor would have the effect of relieving an operator from having to operate the ram manually.

Claims 27, 29, 32, 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helms (US Patent 3,418,845) in view of Wass (US Patent 4,528,840)

As for claim 27 and 29, as discussed above with respect to claim 23 and 25 lacks the apparatus including a support platform. Nevertheless, Helms further discloses a cabinet like structure shown in figure 1 which supports the test apparatus. However, Helms lacks the support platform being moveable along a floor surface on devices for reducing friction between the platform and the floor surface, the clamp and the tank being mounted on the platform.

Wass teaches a test stand 10 mounted on a moveable cart 14 as shown in figure 1. The cart is shown with four wheels 22 which are devices, which will reduce friction between the cart, test stand and the floor.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a support platform, which is moveable along a floor surface on wheels. "This allows test stand ... to be moved from place-to-place, as needed, and then moved to a storage location when not in use." (column 3 lines 63-66)

As for claims 32 and 33, as discussed above with respect to claims 27 and 29, the devices are in fact wheels.

Claims 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helms (US Patent 3,418,845) as modified by Wass (US Patent 4,528,840) and applied to claims 27 and 29 above and further in view of Wise (US Patent 5,642,898)

The references lack the platform has at least one connector for removably connecting the apparatus to a source of electricity.

Wise teaches a cart 10 with a power strip 36 and plug 34.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a power strip and plug for advantageously providing electricity to various accessories (abstract) which may be carried by the cart.

Claims 35 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helms (US Patent 3,418,845) as modified by Wass (US Patent 4,528,840) and applied to claims 27 and 29 above and further in view of Albertson (US Patent 4,378,034).

The references lack the platform with at least one connector for removably connecting the apparatus to a source of pressurized air.

Albertson teaches an air line 46 releasably attached to a connector 47 mounted on top plate 37 functions to supply air under pressure to apparatus 20.

Claim 38, 39, 42, 43, 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helms (US Patent 3,418,845) in view of Konieczka (US Patent 5,535,618) and Hoffman (DE 3827744A1)

Regarding claims 38 and 39, Helms discloses a can body testing machine. The recitation that testing is on "liquid-filled" containers has not been given patentable

weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

The apparatus includes a clamp having a first and second clamping elements (22, 23) or members for securing a container between the members as shown in figures 4 and 5.

Cylinder 41 with rod 43 is a ram connected to the clamping elements to provide relative movement between the first and second elements or members.

Tank 49 is a liquid-filled tank situated with respect to the clamp such that at least a portion of a container secured between the first and second members may extend into the tank and a closure of the container be submerged in the liquid as shown sequentially in figure 2 and 3.

Helms lacks a conductivity evaluating instrument including a first and second electrode, an electrode is in contact with the liquid in the container and the second electrode of the instrument being immersed in the liquid in the tank.

Konieczka teaches a seal integrity evaluation method including first and second electrodes (1, 13) wherein electrode 1 is in contact with the liquid in the container 2 and the second electrode of the instrument being immersed in the liquid 9 in the tank 14. (see figure 1 and column 3 line 61 to column 4 line 38)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a conductivity evaluating instrument including a first and second electrode, an electrode is in contact with the liquid in the container and the second electrode of the instrument being immersed in the liquid in the tank. Such an instrument provides a "simple, easy to carry out, and inexpensive method for testing for seal leaks in sealed containers having seals which can be opened and containing electrolyte product compositions."

The references also lack means for forming an aperture in a container wherein a first electrode being integrated with the means for forming an aperture such that when the means for forming an aperture penetrates a wall of a container, without removing the means for forming an aperture from the container.

Hoffman teaches a first electrode (14 or 15) inserted through a container wall thus forming an aperture and placing the electrode in contact with the liquid within. (see figures 1, 2, 3). This could occur while the container was secured in a clamp.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to insert electrodes through a container wall to come into contact with the liquid within in order to determine an electrical property of the liquid within. (See Derwent abstract)

As for claims 42 and 43, Examiner takes Official Notice that it is widely known that means for forming an aperture in a container may include a drill, a heated lance, a mechanical punch and an electrode and one of ordinary skill will understand that a

punch, a heated lance or any equivalent for drilling or piercing a wall of the container will suffice.

As for claim 49, Konieczka further teaches the sealed container is not leaking if there is no electric current flowing or electrical conductivity between the two electrodes, and the sealed container is leaking if there is electric current flowing or electrical conductivity between the two electrodes. This is considered to be substantively equivalent to electrically comparing the first and second electrodes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to compare the potential between the electrodes as it is the basis for the "simple, easy to carry out, and inexpensive method for testing for seal leaks in sealed containers having seals which can be opened and containing electrolyte product compositions."

Claims 40, 41, 44-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helms (US Patent 3,418,845) in view of Konieczka (US Patent 5,535,618).

Regarding claims 40, 41, Helms discloses a can body testing machine. The recitation that testing is on "liquid-filled" containers has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

The apparatus includes a clamp having a first and second clamping elements (22, 23) or members for securing a container between the members as shown in figures 4 and 5.

Cylinder 41 with rod 43 is a ram connected to the clamping elements to provide relative movement between the first and second elements or members.

Tank 49 is a liquid-filled tank situated with respect to the clamp such that at least a portion of a container secured between the first and second members may extend into the tank and a closure of the container be submerged in the liquid as shown sequentially in figure 2 and 3.

Helms lacks a conductivity evaluating instrument including a first and second electrode, an electrode is in contact with the liquid in the container and the second electrode of the instrument being immersed in the liquid in the tank.

Konieczka teaches a seal integrity evaluation method including first and second electrodes (1, 13) wherein electrode 1 is in contact with the liquid in the container 2 and the second electrode of the instrument being immersed in the liquid 9 in the tank 14. (see figure 1 and column 3 line 61 to column 4 line 38). The first electrode is shown to be moveable and sized such that it can be inserted into an aperture formed in the container and extends into the liquid in the container.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a conductivity evaluating instrument including a first and second electrode, an electrode moveable and sized in order to contact the liquid in the container and the second electrode of the instrument being immersed in the liquid in the

tank. Such an instrument provides a “simple, easy to carry out, and inexpensive method for testing for seal leaks in sealed containers having seals which can be opened and containing electrolyte product compositions.”

As for claims 44 and 45, Examiner takes Official Notice that it is widely known that means for forming an aperture in a container may include a drill, a heated lance, a mechanical punch and an electrode and one of ordinary skill will understand that a punch, a heated lance or any equivalent for drilling or piercing a wall of the container will suffice.

As for claim 46, Konieczka further teaches the sealed container is not leaking if there is no electric current flowing or electrical conductivity between the two electrodes, and the sealed container is leaking if there is electric current flowing or electrical conductivity between the two electrodes. This is considered to be substantively equivalent to electrically comparing the first and second electrodes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to compare the potential between the electrodes as it is the basis for the “simple, easy to carry out, and inexpensive method for testing for seal leaks in sealed containers having seals which can be opened and containing electrolyte product compositions.”

As for claim 47, Examiner takes Official Notice that it is widely known to electrically compare conductance, dielectric value, impedance, inductance, current, resistance and capacitance and one having ordinary skill in the art would have known that any of these are advantageous alternatives for comparing the electrical potential that may exist across a leak.

As for claim 48, as discussed above, Helms disclosed the step of securing a container in the clamp includes the step of closing the clamp with a ram.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Garber whose telephone number is (703) 308-6062. The examiner can normally be reached on 6:30 a.m. to 3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams can be reached on (703) 305-4705. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.



cdg